

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Appellants: Comstock et al.

Title: SYSTEM AND METHOD FOR CREDITING  
AN ACCOUNT ASSOCIATED WITH A  
NETWORK ACCESS NODE

Appl. No.: 09/871,111

Filing Date: 5/31/2001

Examiner: Taylor, Barry W.

Art Unit: 2617

Confirmation 9798  
Number:

**BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with payment in the amount of \$540.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 19-0741.

This Appeal Brief is being filed in response to the Final Office Action dated July 27, 2009, and the Advisory Action dated October 7, 2009, finally rejecting claims 2-7, 9-13, 15-22, 29-30, 32-34, 37-40, 43, 45-49, and 60-69.

**REAL PARTY IN INTEREST**

The real party in interest is Palm, Inc., having a place of business at 950 West Maude Avenue, Sunnyvale, CA, 94085.

**RELATED APPEALS AND INTERFERENCES**

The Appeal Brief filed March 30, 2009, in Application No. 10/158,338 may be related to this Appeal. No court or Board decisions were rendered in Application No. 10/158,338.

Appeal No. 2007-0251 in Application No. 10/085,310 may be related to this Appeal.

**STATUS OF CLAIMS**

The status of the claims is as follows:

Claims 1, 8, 14, 23-28, 31, 35-36, 41-42, 44, and 50-59 are cancelled.

Claims 2-7, 9-13, 15-22, 29-30, 32-34, 37-40, 43, 45-49, and 60-69 are pending and currently rejected.

Claims 2-7, 9-13, 15-22, 29-30, 32-34, 37-40, 43, 45-49, and 60-69 are being appealed.

**STATUS OF AMENDMENTS**

An Amendment and Reply was filed on September 28, 2009, after the mailing date of the Final Office Action. In the Advisory Action dated October 7, 2009, the Examiner indicated that the proposed amendments in the Amendment and Reply dated September 28, 2009 would not be entered for purposes of Appeal.

**SUMMARY OF CLAIMED SUBJECT MATTER**

Claim 7 is directed to a method of crediting an account of a network access node. (Page 7, lines 6-12). The method includes receiving a data signal wirelessly at the network access node (20) (page 7, lines 17-20), forwarding the data signal wirelessly to a network user node (22, 24) (page 7, lines 17-20), providing account crediting information to an accounting system (32), wherein the account crediting information represents a credit to be recorded for an account associated with the network access node (20) (page 11, lines 8-12), and providing second account crediting information to the accounting system (32). The second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider (30). The Internet service provider (30) provides access to the Internet (28) via a fixed access point (18), and the data signal is provided by the Internet service provider (30). (Page 11, lines 26-29; page 6, lines 8-10). The network access node (20) is a portable, handheld device having a display. (Page 7, lines 9-11).

Claim 17 is directed to a portable device configured as a repeater. (Page 3, lines 13-20). The portable device (20) includes means for receiving a data signal wirelessly at the portable device (20) (page 7, lines 17-20), means for forwarding the data signal wirelessly from the portable device (20) to a network user node (22, 24) (page 7, lines 17-20), means for providing account crediting information to an accounting system (32), wherein the account crediting information represents a credit to be recorded for an account associated with the portable device (20) (page 11, lines 8-12), and means for providing second account crediting information to the accounting system (32). The data signal is provided by an Internet service provider (30), the

second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider (30), and the Internet service provider (30) provides access to the Internet (28) via a fixed access point (18). (Page 11, lines 26-29; page 6, lines 8-10).

Claim 17 contains elements drafted in means-plus-function format, including means for receiving data signal wirelessly at the portable device (page 7, lines 5-20); means for forwarding the data signal wirelessly from the portable device to a network user node (page 7, lines 5-20); means (32) for providing account crediting information to an accounting system, wherein the account crediting information represents a credit to be recorded for an account associated with the portable device (page 9, lines 23-26); and means (32) for providing second account crediting information to the accounting system (page 11, lines 8-12), wherein the data signal is provided by an Internet service provider, wherein the second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point (page 11, lines 26-29).

Claim 29 is directed to an accounting method for crediting an account associated with a network access node. (Page 3, line 21 to page 4, line 4). The method comprises receiving a communication event message, wherein the communication event message includes identification data representing a network access node (20) (page 19, lines 12-18), wherein the communication event message is received in response to the network access node (20) wirelessly receiving and wirelessly forwarding a data signal on behalf of a network user node (22, 24) (page

7, lines 17-20), crediting an account associated with the network access node (20) based on the communication event message (page 11, lines 8-12), and crediting an account associated with an Internet service provider (30), wherein the data signal is provided by the Internet service provider (30), wherein the communication event message includes second identification data representing the Internet service provider (30), and wherein the Internet service provider (30) provides access to the Internet via a fixed access point (18) (page 11, lines 26-29; page 6, lines 8-10; page 19, lines 12-18). The network access node (20) is a portable device (page 7, lines 9-11).

Claim 33 is directed to a method of crediting an account associated with an access point. (Page 4, lines 5-12). The method comprises receiving a data signal wirelessly at the access point (20) (page 7, lines 17-20), forwarding the data signal wirelessly to a network user node (22, 24) using a wireless local area network (WLAN) communication standard (page 7, lines 17-20), providing account crediting information to an accounting system (32), wherein the account crediting information represents a credit to be recorded for an account associated with the access point (20) (page 11, lines 8-12), and providing second account crediting information to the accounting system (32), wherein the second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider (30), wherein the Internet service provider (30) provides access to the Internet via a fixed access point (18) (page 11, lines 26-29; page 6, lines 8-10), wherein the data signal is received from the Internet (28) (page 11, lines 26-29), and wherein the access point (20) is a portable, handheld device having a display (page 7, lines 9-11).

Claim 43 is directed to an access point. (Page 4, lines 13-20). The access point (18) comprises a receive circuit configured to receive a data signal, a transmit circuit configured to transmit the data signal over a wireless local area network (WLAN) to a network user node (22, 24) via a network access node (20) in wireless communication with the network user node (22, 24) (Page 7, lines 17-26), and an accounting circuit (32) configured to provide account crediting information, wherein the account crediting information represents a credit to be recorded for an account associated with the access point (18) (page 11, lines 8-12), wherein the receive circuit is coupled to a public switched telephone network (16), and the data signal is received from an Internet service provider (30) (page 11, lines 8-12), wherein the access point (18) is a portable device (page 7, lines 9-11), and wherein the account crediting information further represents a credit to be recorded for an account associated with the Internet service provider (30), wherein the Internet service provider (30) provides access to the Internet via a fixed access point (page 11, lines 8-12; page 6, lines 8-10).

Claim 65 is directed to a method of adjusting at least one of an account of a first person associated with a network access node and an account of a second person associated with a network user node. (Page 20, lines 3-9). The method comprises receiving a data signal wirelessly at the network access node (20) (page 7, lines 17-20); forwarding the data signal wirelessly to the network user node (22, 24) (page 7, lines 17-20); providing account adjustment information to an accounting system (32), wherein the account adjustment information represents at least one of a credit to be recorded to the first person's account and a debit to be recorded to the second person's account (page 11, lines 8-12; page 20, lines 3-9); and providing second

account information to the accounting system (32), wherein the second account information represents a second credit to be recorded to an account associated with the Internet service provider (30) and the data signal is provided by an Internet service provider (30), wherein the Internet service provider (30) provides access to the Internet (28) via a fixed access point (18) (page 11, lines 8-12; page 6, lines 8-10; wherein the network access node (20) is a portable device (page 7, lines 9-11).

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

1. Whether claims 2-7, 9-10, 12-13, 15-19, 21-22, 29-30, 32-34, 37-38, 40, 43, 45-47, 49, and 60-69 are unpatentable under 35 U.S.C. § 103(a) over Carlson (U.S. Patent Appl. Publ. No. 2002/0071416).

2. Whether claims 11, 20, 39, and 48 are unpatentable under 35 U.S.C. § 103(a) over Carlson in view of Bahl (U.S. Patent No. 7,444,669).

## **ARGUMENT**

### **I. Legal Standards**

All claim rejections at issue in this appeal are made under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). See also KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007) (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

Recently, in KSR Int'l v. Teleflex, the Supreme Court rejected a rigid approach to the question of obviousness. 127 S.Ct. 1727, 1738 (2007). At the same time, however, the Supreme Court recognized that “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” Id. at 1741. Thus, a patent composed of several elements “is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” Id. Therefore, there must be an articulated reasoning with a rational underpinning to support a legal conclusion of obviousness. Id. (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning



with some rational underpinning to support the legal conclusion of obviousness.”) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955,1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). MPEP 2141.02 IV. Also, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01 VI.

## **II. Rejections Under 35 U.S.C. § 103(a)**

### Claims 2-6, 7, 9-10, and 12-13

Independent claim 7 recites a combination including, among other limitations,

providing account crediting information to an accounting system, wherein the account crediting information represents *a credit to be recorded for an account associated with the network access node*; and

providing second account crediting information to the accounting system, wherein the second account crediting information represents *a second credit to be recorded to an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point and the data signal is provided by the Internet service provider.*

Thus, in claim 7 two credits are recorded. One credit is recorded for “an account associated with the network access node,” and a second credit is recorded for “an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.” In rejecting claim 7, the Examiner stated that

Carlson does not use the term “second account”. However, Carlson teaches the Internet Service Provider (i.e., second account) gets paid for the connection services which obviously requires some sort of “account” to be given credit for services rendered – paragraph 0052, Carlson also discloses that the owner of the second wireless portal (item 124) [] also gets credit (i.e. first account) for relay internet messages between the first user device (item 114) and the wireless network (143) – paragraph 0052 which obviously requires the owners account (i.e. first account). In fact, Carlson teaches the owner of the second wireless device (item 124) can even service another wireless device that is willing to pay more for the connection time (paragraph 0057) which obviously provides a higher credit towards the owners account (i.e. first account).

Office Action at p. 4. Appellants submit that the Examiner has failed to establish a prima facie case of obviousness for independent claim 7. Carlson is directed to a system and method for providing a first wireless device access to a wide area network via a second wireless device, where the second wireless device may charge the first wireless device for providing such access. Carlson, ¶ 0026. In Carlson, the second wireless device is also referred to as a “connection provider” or “service provider.” Carlson, ¶¶ 0033, 0043. The billing and payment negotiations in Carlson all appear to be limited to negotiations between the first wireless device and second wireless device. With respect to the Examiner’s statements in the Office Action regarding Carlson’s disclosure of an “Internet Service Provider,” it appears that the Examiner is interpreting the “service provider” of Carlson as a separate Internet service provider from the second wireless device of Carlson. However, as noted above, the phrases “service provider” and “second wireless device” represent the same device (i.e., the second wireless device) in Carlson. Carlson does not disclose, teach, or suggest “providing second account crediting information to the accounting system, wherein the second account crediting information represents *a second credit to be recorded to an account associated with an Internet service provider, wherein the*

*Internet service provider provides access to the Internet via a fixed access point,”* as provided by claim 7. The second wireless device of Carlson, although referred to as a “service provider,” is not an Internet Service Provider, as recited in claim 7. Claim 7 provides that “the Internet service provider provides access to the Internet via a fixed access point.” In Carlson, the second wireless device is a mobile device. Appellants have found no portion of Carlson that discloses crediting an account associated with an Internet service provider as in claim 7. The feature of recording a credit to an account associated with an Internet service provider, as in claim 7, appears to be completely missing from Carlson.

Further, to the extent the Examiner interprets the second wireless device wired to wide area network 143 / the Internet (e.g., a fixed access point) to be a “fixed access point” as provided by claim 7, Appellants submit that the second wireless device of Carlson would then not wirelessly receive and forward data signals, as provided by claim 7.

In the Advisory Action, the Examiner further stated:

Furthermore, using one account for both the mobile wireless access point and Internet service provider or using two separate accounts for the mobile wireless access point and Internet Service provider would have been an obvious measure to one of ordinary skill in the art at the time of invention.

Advisory Action at p. 3. Appellants disagree, and submit that one of ordinary skill in the art would not be led to modify Carlson as suggested by the Examiner. The feature of providing separate accounts for both a network access node and an Internet Service Provider, as in claim 7 of the present application, is completely missing from Carlson, and the Examiner has cited to no additional references in support of such a teaching. The Examiner’s conclusory remarks in the Office Action, coupled with the Examiner’s reliance on Appellant’s own disclosure, amount to improper hindsight reasoning.

Accordingly, Appellants submit that the subject matter of claim 7, and corresponding dependent claims 2-6, 9-10, and 12-13, would not have been obvious in view of the disclosure of Carlson.

Claim 6

Dependent claim 6 is believed to be further patentable over Carlson. Dependent claim 6 recites

providing account debiting information to the accounting system, wherein the account debiting information represents a debit to be recorded for an account associated with the network user node.

Taken in conjunction with the limitations of claim 7 incorporated therein, claim 6 provides for recording two credits and one debit, each for a different entity. Thus, accounts associated with three separate entities (i.e., a network access node, an Internet service provider, and a network user node) are involved in the accounting features of claim 7. As discussed above, the billing and payment negotiations of Carlson involve only two entities – the first wireless device and the second wireless device. The feature of providing accounting information (e.g., credits and/or debits) for three separate entities is completely missing from Carlson. Thus, claim 6 is believed to be further patentable over Carlson.

Claim 12

Dependent claim 12 is believed to be further patentable over Carlson. Dependent claim 12 recites

wherein the step of forwarding includes transmitting the data signal using a wireless local area network (WLAN) protocol.

The Examiner stated in the final office Action that

Carlson teaches wherein the step of forwarding includes transmitting the data signal using a wireless local area network (WLAN) protocol (see 802.11 in paragraph 0005, see figure 1

wherein portable handheld device (item 124 figure 1) communicates wirelessly with Internet Service Provider).

Office Action at p. 6. The cited portion of Carlson states:

For example, a wireless Ethernet protocol supports the use of the 802.11 protocol to connect a laptop to a local area network (LAN) so the laptop can access LAN resources (e.g., a printer connected to the LAN).

Carlson at ¶ [0005]. However, Carlson does not teach or suggest “wherein the step of forwarding includes transmitting the data signal using a wireless local area network (WLAN) protocol,” as recited in claim 12. Accordingly, claim 12 is believed to be further patentable over Carlson.

#### Claims 15-19 and 21-22

Independent claim 17 recites a combination including, among other limitations,

means for providing account crediting information to an accounting system, wherein the account crediting information represents a credit to be recorded for an account associated with the portable device;

means for providing second account crediting information to the accounting system, wherein the data signal is provided by an Internet service provider, wherein the second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.

Independent claim 17, and corresponding dependent claims 15-16, 18-19, and 21-22, are believed to be patentable for the same reasons that claim 7 is patentable.

#### Claims 29-30

Independent claim 29 recites a combination including, among other limitations,

crediting an account associated with the network access node based on the communication event message; and

crediting an account associated with an Internet service provider, wherein the data signal is provided by the Internet service provider, wherein the communication event message includes second identification data representing the Internet service provider, and wherein the Internet service provider provides access to the Internet via a fixed access point.

Independent claim 29, and corresponding dependent claim 30, are believed to be patentable for the same reasons that claim 7 is patentable.

Claims 32-34, 37-38, and 40

Independent claim 33 recites a combination including, among other limitations,

providing account crediting information to an accounting system, wherein the account crediting information represents a credit to be recorded for an account associated with the access point,

providing second account crediting information to the accounting system, wherein the second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.

Independent claim 33, and corresponding dependent claims 32, 34, 37-38, and 40, are believed to be patentable for the same reasons that claim 7 is patentable.

Claims 43, 45-47, and 49

Independent claim 43 recites a combination including, among other limitations,

an accounting circuit configured to provide account crediting information, wherein the account crediting information represents a credit to be recorded for an account associated with the access point,

...

wherein the account crediting information further represents a credit to be recorded for an account associated with the Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.

Independent claim 43, and corresponding dependent claims 45-47 and 49, are believed to be patentable for the same reasons that claim 7 is patentable.

#### Claims 60-69

Independent claim 65 recites a combination including, among other limitations,

providing account adjustment information to an accounting system, wherein the account adjustment information represents at least one of a credit to be recorded to the first person's account and a debit to be recorded to the second person's account; and

providing second account information to the accounting system, wherein the second account information represents a second credit to be recorded to an account associated with the Internet service provider and the data signal is provided by an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.

Independent claim 65, and corresponding dependent claims 61-64 and 66-69, are believed to be patentable for the same reasons that claim 7 is patentable.

#### Dependent Claims 11, 20, 39, and 48

On page 22 of the Office Action, the Examiner rejected claims 11, 20, 39, and 48 under 35 U.S.C. 103(a) as being unpatentable over Carlson in view of U.S. Patent No. 7,444,669 to Bahl et al. (Bahl). Claims 11, 20, 39, and 48 variously depend from independent claims 7, 17, 33, and 43, which are patentable over Carlson. Bahl was relied on by the Examiner for a teaching of monitoring usage of connection services on a per packet or per byte basis. Bahl does not cure the deficiencies of Carlson with respect to independent claims 7, 17, 33, and 43, from

which claims 11, 20, 39, and 48 depend. Accordingly, dependent claims 11, 20, 39, and 48 are patentable over the combination of Carlson and Bahl.

## **II. Conclusion**

In view of the foregoing, Appellants submit that the currently pending claims are not properly rejected as being unpatentable over the cited references. Accordingly, it is respectfully requested that the Board reverse the claim rejections and indicate that a Notice of Allowance respecting all pending claims be issued.

Respectfully submitted,

Date     /12-28-2009/    

By     /Matthew J. Swietlik/    

FOLEY & LARDNER LLP  
Customer Number: 26371  
Telephone: (414) 319-7306  
Facsimile: (414) 297-4900

Matthew J. Swietlik  
Attorney for Appellant  
Registration No. 58,428



**CLAIMS APPENDIX**

1. (Canceled)
2. (Previously Presented) The method of claim 7, wherein the network access node is a repeater.
3. (Original) The method of claim 2, wherein the network access node is further part of an ad hoc network.
4. (Previously Presented) The method of claim 7, wherein the network access node is an access point.
5. (Original) The method of claim 4, wherein the data signal is received from a public telephone.
6. (Previously Presented) The method of claim 7, further comprising providing account debiting information to the accounting system, wherein the account debiting information represents a debit to be recorded for an account associated with the network user node.
7. (Previously Presented) A method of crediting an account of a network access node, comprising:
  - receiving a data signal wirelessly at the network access node;
  - forwarding the data signal wirelessly to a network user node;

providing account crediting information to an accounting system, wherein the account crediting information represents a credit to be recorded for an account associated with the network access node; and

providing second account crediting information to the accounting system, wherein the second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point and the data signal is provided by the Internet service provider;

wherein the network access node is a portable, handheld device having a display.

8. (Canceled)
9. (Previously Presented) The method of claim 7, wherein the credit is based on the forwarded data signal.
10. (Original) The method of claim 9, wherein the credit is based on at least one of the time of day and airtime usage of the data signal.
11. (Original) The method of claim 9, wherein the credit is calculated on at least one of a per-packet basis and a flat rate basis.
12. (Previously Presented) The method of claim 7, wherein the step of forwarding includes transmitting the data signal using a wireless local area network (WLAN) protocol.

13. (Original) The method of claim 12, wherein the WLAN protocol is the IEEE 802.11 protocol.

14. (Canceled)

15. (Previously Presented) The portable device of claim 17, wherein the portable device is configured to operate in an ad hoc network.

16. (Previously Presented) The portable device of claim 17, further comprising means for providing account debiting information to the accounting system, wherein the account debiting information represents a debit to be recorded for an account associated with the network user node.

17. (Previously Presented) A portable device configured as a repeater, comprising:  
means for receiving a data signal wirelessly at the portable device;  
means for forwarding the data signal wirelessly from the portable device to a network user node;  
means for providing account crediting information to an accounting system, wherein the account crediting information represents a credit to be recorded for an account associated with the portable device;  
means for providing second account crediting information to the accounting system, wherein the data signal is provided by an Internet service provider, wherein the second account crediting information represents a second credit to be recorded to an account associated

with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.

18. (Previously Presented) The portable device of claim 17, wherein the credit is based on the forwarded data signal.

19. (Original) The portable device of claim 18, wherein the credit is based on airtime usage of the data signal.

20. (Original) The portable device of claim 18, wherein the credit is calculated on a per-packet basis of the data signal.

21. (Previously Presented) The portable device of claim 17, wherein the means for forwarding includes a wireless local area network (WLAN) transmitter.

22. (Original) The portable device of claim 21, wherein the network user node is a portable device.

23-28. (Canceled)

29. (Previously Presented) An accounting method for crediting an account associated with a network access node, comprising:

receiving a communication event message, wherein the communication event message includes identification data representing a network access node, wherein the

communication event message is received in response to the network access node wirelessly receiving and wirelessly forwarding a data signal on behalf of a network user node;

crediting an account associated with the network access node based on the communication event message; and

crediting an account associated with an Internet service provider, wherein the data signal is provided by the Internet service provider, wherein the communication event message includes second identification data representing the Internet service provider, and wherein the Internet service provider provides access to the Internet via a fixed access point;

wherein the network access node is a portable device.

30. (Previously Presented) The accounting method of claim 29, wherein the network access node receives and forwards the data signal via a wireless local area network (WLAN) protocol.

31. (Canceled)

32. (Previously Presented) The method of claim 33, wherein the data signal is received from a public telephone.

33. (Previously Presented) A method of crediting an account associated with an access point, comprising:

receiving a data signal wirelessly at the access point;

forwarding the data signal wirelessly to a network user node using a wireless local area network (WLAN) communication standard; and

providing account crediting information to an accounting system, wherein the account crediting information represents a credit to be recorded for an account associated with the access point,

providing second account crediting information to the accounting system, wherein the second account crediting information represents a second credit to be recorded to an account associated with an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point;

wherein the data signal is received from the Internet; and

wherein the access point is a portable, handheld device having a display.

34. (Previously Presented) The method of claim 33, further comprising providing account debiting information to the accounting system, wherein the account debiting information represents a debit to be recorded for an account associated with the network user node.

35. (Canceled)

36. (Canceled)

37. (Previously Presented) The method of claim 33, wherein the credit is based on the forwarded data signal.

38. (Previously Presented) The method of claim 33, wherein the credit is based on airtime usage of the data signal.

39. (Previously Presented) The method of claim 33, wherein the credit is calculated on a per-packet basis.

40. (Previously Presented) The method of claim 33, wherein the wireless local area network protocol is the IEEE 802.11 protocol.

41-42. (Canceled)

43. (Previously Presented) An access point, comprising:  
a receive circuit configured to receive a data signal;  
a transmit circuit configured to transmit the data signal over a wireless local area network (WLAN) to a network user node via a network access node in wireless communication with the network user node; and  
an accounting circuit configured to provide account crediting information, wherein the account crediting information represents a credit to be recorded for an account associated with the access point,  
wherein the receive circuit is coupled to a public switched telephone network; and the data signal is received from an Internet service provider;  
wherein the access point is a portable device; and  
wherein the account crediting information further represents a credit to be recorded for an account associated with the Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point.

44. (Cancelled)

45. (Previously Presented) The access point of claim 43, wherein the wireless local area network operates according to the IEEE 802.11 standard.

46. (Previously Presented) The access point of claim 43, wherein the credit is based on the transmitted data signal.

47. (Previously Presented) The access point of claim 43, wherein the credit is based on airtime usage of the data signal.

48. (Previously Presented) The access point of claim 43, wherein the credit is calculated on a per-packet basis.

49. (Previously Presented) The access point of claim 43, wherein the accounting circuit is further configured to provide account debiting information, wherein the account debiting information represents a debit to be recorded for an account associated with the network user node.

50-59. (Canceled)

60. (Previously Presented) The method of claim 65, wherein the network access node is a repeater.

61. (Original) The method of claim 60, wherein the network access node is further part of an ad hoc network.



62. (Previously Presented) The method of claim 65, wherein the network access node is an access point.

63. (Previously Presented) The method of claim 65, wherein the account information represents a credit to be recorded to the first person's account.

64. (Previously Presented) The method of claim 65, wherein the account information represents a debit to be recorded to the second person's account.

65. (Previously Presented) A method of adjusting at least one of an account of a first person associated with a network access node and an account of a second person associated with a network user node, comprising:

receiving a data signal wirelessly at the network access node;

forwarding the data signal wirelessly to the network user node;

providing account adjustment information to an accounting system, wherein the account adjustment information represents at least one of a credit to be recorded to the first person's account and a debit to be recorded to the second person's account; and

providing second account information to the accounting system, wherein the second account information represents a second credit to be recorded to an account associated with the Internet service provider and the data signal is provided by an Internet service provider, wherein the Internet service provider provides access to the Internet via a fixed access point;

wherein the network access node is a portable device.

66. (Previously Presented) The method of claim 65, wherein the network user node is a portable, handheld device having a display.

67. (Previously Presented) The method of claim 65, wherein the credit is based on the forwarded data signal.

68. (Previously Presented) The method of claim 65, wherein the step of forwarding includes transmitting the data signal using a wireless local area network (WLAN) protocol.

69. (Original) The method of claim 68, wherein the WLAN protocol is the IEEE 802.11 protocol.

**EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

See Attached.

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* SHERRIDYTHE A. FRASER, SHAWN R. GETTEMY,  
KEVIN LEE, YOON KEAN WONG, and LAWRENCE LAM

---

Appeal 2007-0251  
Application 10/085,310  
Technology Center 2600

---

Decided: March 12, 2007

---

Before JOSEPH L. DIXON, LANCE LEONARD BARRY, and HOWARD  
B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-15 and 17-29, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

## INTRODUCTION

The claims relate to a handheld computing device featuring interchangeable display units. Claim 15 is illustrative:

15. A handheld computing device facilitating a detachable visual display unit comprising:

a processing unit;

a power source;

a communication port for communicating with a detachable visual display unit, wherein the communication port is capable of receiving information representative of properties of the detachable visual display unit.

The Examiner relies on the following prior art reference to show unpatentability:

Moriconi	US 6,590,547 B2	Jul. 8, 2003
----------	-----------------	--------------

The rejection as presented by the Examiner is as follows:

1. Claims 1-15 and 17-29 are rejected under 35 U.S.C § 103(a) as unpatentable over Moriconi.

## OPINION

Representative claim 15 purports a “handheld computing device” in the preamble. Appellants do not dispute that Moriconi describes a portable computer (e.g., a notebook computer) having structure that meets the terms recited in the body of the claim. Appellants argue, however, that (1) the preamble recitation represents a limitation of the claim and (2) the definition of “handheld computing device” distinguishes the claim over Moriconi.

(Reply Br. 4.)

Appellants submit that the claim preamble limits the structure of the claimed invention to a handheld computer that can be conveniently stored in a pocket. We find nothing in the preamble, nor in the body of the claim, that mentions storage in any pocket. The body of the claim appears to set forth a structurally complete invention, without the need to presume that the preamble further sets forth structure that is necessary for completion. The preamble thus may be read as merely providing a name for the device. The preamble of a claim does not limit the scope of the claim when it merely states a purpose or intended use of the invention. *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Appellants further submit that the preamble has been relied upon during prosecution to distinguish the claimed invention from Moriconi, and thus represents a limitation, relying on a quotation from *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-09, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002).

In our view, the assertion of a principle relating to a patent controversy in U.S. District Court (infringement) litigation is misplaced. Here, there is no “prosecution history” because the prosecution is ongoing; the history is thus incomplete. Further, unlike proceedings in a District Court, the claims in an application may be amended to be commensurate with arguments made during prosecution, to the extent the amendments are supported by the disclosure, and thus remedy uncertainty as to the scope of a claim. “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can

uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, F.2d 893 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

We are therefore not persuaded that the preamble recitation of claim 15 limits the scope of the claimed subject matter. We will, however, consider the second part of Appellants’ argument, assuming *arguendo* that “handheld computing device” represents a limitation.

Appellants suggest (Br. 8-9) that the specification provides a limiting definition for the term in controversy. Appellants point to paragraph 3 of the specification, which speaks only in general terms of “handheld computing devices,” using terms of degree such as “compact” and “small.” Appellants seem to acknowledge that the display screen sizes described by Moriconi are smaller than the size of a “standard” computer monitor, but seem to allege that the size of the displays described by Moriconi are somewhere between the size of a standard computer monitor and Appellants’ undefined “smaller” display. We do not consider the proposal to define a device by its ease of “viewing complex images of documents” (Br. 9) to be helpful in determining whether instant claim 15 distinguishes over the reference.

Appellants also submit that paragraph 22 of the specification states that a handheld computer can be “a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any such device.” (Br. 9.)

Actually, paragraph 22 of the specification describes the embodiment of processing unit 110 (Fig. 1A), rather than setting forth any definition of “handheld computing device.” Further, the section does not state that a handheld computer can be any of the things alleged by Appellants in the



Brief, but states that processing unit 110 can be “a handheld computer, a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any other such device.” The specification thus provides a list of four things that processing unit 110 may be, and then teaches that the unit is not limited to the four examples.

Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). We are not persuaded that the specification provides a useful definition for “handheld computing device.”

Appellants submit the alternative argument that the artisan would have understood the term “handheld computing device” to exclude the structures described by Moriconi. In support of that view, Appellants refer to two papers attached to the Brief in the Evidence Appendix.

One piece of evidence appears to be a printed copy from the Web page “SearchMobileComputing.com,” addressing the word “handheld.” The paper states that a handheld computer “is a computer that can conveniently be stored in a pocket (of sufficient size) and used while you’re holding it.” The next sentence indicates that “handheld computer” and “PDA” are synonymous -- i.e., “Today’s handheld computers, which are also called personal digital assistants (PDAs) . . . .” That sentence, however, is contrary to Appellants’ specification (§ 22), which teaches that a handheld computer is distinct from a PDA.

Moreover, the evidence provided from the Web page (apparently printed February 11, 2004) was last updated on September 9, 2003 (second printed page) and copyrighted “2003-2004” (third printed page). The instant application was filed February 28, 2002. The proffered evidence thus does not necessarily reflect the artisan’s understanding of the term at the time of invention (on this record, February 28, 2002).

Appellants also rely on a definition for “handheld computer” from another Web page, which designates 1997 as the date of copyright. According to the single entry, “handheld computer” is defined as “a computer small enough to be carried in your pocket.”

The “definition” is, manifestly, informal. Pockets come in a great variety of sizes, ranging from thimble-sized to very large (e.g., a pocket in an apron, a farmer’s overalls, a pocketbook, or a backpack). The entity that provided the asserted definition could not know the size of the reader’s pocket. We cannot surmise what the size of “your” pocket may be, at this time or in any future time, without knowing who “you” are and what “you” are wearing or otherwise possess. Such a “definition” would not provide reasonable notice as to what the claim might include or exclude.

Moreover, the evidence provided by Appellants may speak to the meaning of “handheld computer,” but Appellants are not claiming a “handheld computer.” The preamble of instant claim 15 purports a “handheld computing device.” Appellants’ evidence does not demonstrate that the artisan would have considered the term “handheld computing device” as excluding the laptop or notebook computers described by Moriconi.

For the foregoing reasons, we sustain the rejection of claim 15, and of claims 1, 3, 6-15, 17-19, 22, and 25-29 that are not separately argued.

Appellants argue claims 4, 5, 23, and 24 under a separate heading. (Br. 11-12.) We find that the arguments in defense of that group of claims rely on the argument that we have found unpersuasive; i.e., the proposition that the claims require a handheld computing device and Moriconi fails to teach a handheld computing device. Appellants' not showing error in the rejection, we sustain the rejection of claims 4, 5, 23, and 24.

We agree with Appellants, however, that the Examiner has not set forth a prima facie case for unpatentability with respect to the subject matter of claims 2, 20, and 21. We find no basis in this record for the position that Moriconi at column 4, lines 57 through 59, and Figures 2 and 4, would have suggested that connector 39 could be replaced with "any other appropriate type" (Answer 4 and 7). Nor has the Examiner provided any evidentiary basis for the position that a multi-pin electrical connector and a wireless interface were art-recognized equivalents at the time of the invention. (Answer 11.) We thus do not sustain the rejection as to claims 2, 20, and 21.

Appeal 2007-0251  
Application 10/085,310

### CONCLUSION

In summary, we affirm the rejection of claims 1, 3-15, 17-19, and 22-29 but reverse the rejection of claims 2, 20, and 21 under 35 U.S.C § 103(a) over Moriconi. The Examiner's decision is thus affirmed-in-part.

### AFFIRMED-IN-PART

PGC

FOLEY & LARDNER LLP  
777 East Wisconsin Avenue  
Milwaukee, WI 53202-5306

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Ting et al.  
Title: DYNAMIC NETWORKING MODES METHOD AND APPARATUS  
Appl. No.: 10/158,338  
Filing Date: 5/30/2002  
Examiner: Milord, Marceau  
Art Unit: 2618  
Confirmation No.: 6562

**NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD  
OF PATENT APPEALS AND INTERFERENCES**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action dated September 29, 2008, and in the Advisory Action dated December 16, 2008, finally rejecting Claims 1-10 and 13-22.

- ☐ Applicant claims small entity status.
- ☐ Applicant hereby petitions for an extension of time under 37 C.F.R. §1.136(a) for the total number of months checked below:
- ☒ Notice of Appeal Fee
- ☒ To be paid as detailed below
- ☐ Not required (Fee paid in prior appeal)

The required fees are calculated below:

<input checked="" type="checkbox"/>	Notice of Appeal Fee	\$540.00
<input type="checkbox"/>	Extension month:	\$0.00
<input type="checkbox"/>	Extension:	\$0.00
	FEE TOTAL:	\$540.00
<input type="checkbox"/>	Small Entity Fees Apply (subtract ½ of above):	\$0.00
	TOTAL FEE:	\$540.00

The above-identified fees of \$540.00 are being paid by credit card via EFS-Web.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16, 1.17 and 41.20, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date /December 29, 2008/\_\_\_\_\_

By /Steven C. Becker/\_\_\_\_\_

FOLEY & LARDNER LLP  
 Customer Number: 26371  
 Telephone: (414) 297-5571  
 Facsimile: (414) 297-4900

Steven C. Becker  
 Attorney for Applicant  
 Registration No. 42,308